

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DALLAS W. MEYER

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Appeal No. 96-2747  
Application 08/245,518<sup>1</sup>

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ON BRIEF

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Before COHEN, ABRAMS and LEE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed May 18, 1994. According to appellant, the application is a continuation of Application 07/998,103, filed December 29, 1992, now abandoned.

This is an appeal from the decision of the examiner finally rejecting claims 2 through 5, 7 and 8, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to an improved slider for an information storage system. The subject matter before us on appeal is illustrated by reference to claim 2.

2. An improved slider for an information storage system having an information storage medium including an exposed surface at least partly covered with an incompressible fluid, the improved slider comprising:

a face region which is exposed to the incompressible fluid located on the exposed surface of the information storage medium during operation of the information storage system, the face region having a length, a width, a pair of opposing sides extending across the length of the face region, two opposite ends which extend across the width of the face region and perpendicular to the opposing sides;

at least one of the opposite ends having a partially controlled, textured surface with a patterned roughness extending lengthwise across the width of the face region; and

at least one bearing pad having a length and a width and located at least partially within at least one end and having at least a partially controlled, textured surface with a patterned roughness comprising a plurality of triangle shaped grooves extending lengthwise across substantially the entire width of the bearing pad each of said triangle shaped grooves having a vertex extending into said bearing pad.

#### *THE REFERENCES*

The references relied upon by the examiner to support the final rejection are:

Aronoff et al. (Aronoff)	5,079,657	Jan. 7, 1992
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Albrecht et al. (Albrecht)                      5,200,867                      Apr. 6, 1993

*THE REJECTION*

Claims 2 through 5, 7 and 8 stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over Albrecht in view of Aronoff.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in  
the Brief.

*OPINION*

According to the appellant, in a disk drive or direct access  
storage device, a transducer reads the information from, or  
writes information on the various tracks of the disk. The  
transducer is attached to a slider which is suspended from an  
arm. The slider is carried on the surface of the disks either by  
a cushion of compressed gas, or by a layer of incompressible  
fluid. In the latter system, the slider "skis" on the thin layer  
of incompressible fluid, causing some fluid to be displaced,  
which eventually results in a diminishment of the fluid thickness  
over the tracks, an undesirable situation. Specification, pages  
1 through 3.

As manifested in independent claims 2 and 7, the appellant's  
invention solves this problem by providing on at least a portion  
of the face of the slider a "textured surface with a patterned

roughness extending lengthwise across the width," and at least one bearing pad on this portion of the face having a textured roughness on its face "comprising a plurality of triangle shaped grooves extending lengthwise . . . having a vertex extending into said bearing pad."

The claims have been rejected on the basis of the combined teachings of Albrecht and Aronoff. It is the examiner's position that Albrecht teaches everything in the independent claims except the triangle shaped grooves on the pads, which is taught by Aronoff, and that it would have been obvious to one of ordinary skill in the art to modify the Albrecht device in such a manner as to meet the terms of the appellant's claims. We disagree.

Albrecht teaches etching the flat surface of a slider in order to produce a plurality of bearing pads the faces of which, in the absence of evidence to the contrary, must be presumed also to be flat (column 5, lines 14 through 31). Even if one were to embrace the examiner's position that it would have been obvious to texture these faces in view of the showing of Aronoff (Answer, page 4), we agree with the appellant that the result would not have been the required triangle shaped grooves having a vertex extending into the bearing pad. In this regard, the extent of

Aronoff's teaching in Figure 3, to which the examiner referred, is a pattern of "repetitions of non-circular curves" whose function is to form a path to facilitate fluid communication across the surface of the slider (column 5, lines 25 through 31). At best, therefore, Aronoff would have suggested this pattern to

one of ordinary skill in the art. Moreover, in Aronoff the texturing is used on the face of the slider itself, there being no showing of bearing pads at all, much less a teaching that texturing is useful on them.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill

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in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify Albrecht in the manner proposed by the examiner. From our perspective, the only suggestion for doing so is found via the luxury of the hindsight accorded one who first viewed the appellant's specification. That, of course, is impermissible.

The rejection is not sustained,

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

NEAL E. ABRAMS

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Administrative Patent Judge	)	APPEALS AND
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JAMESON LEE	)	
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